

### **REMARKS**

Claims 9 and 15 have been amended to further define that the linear depressions are formed in both the foam sheet and the non-foam layer. Support can be found in, for example, Figure 2 of the application as filed. Additionally, new claim 19 has been added. Support for new claim 19 can be found, for example, in Figure 3(c) as well as in the third paragraph on page 9 of the application as filed. Thus, no new matter has been added. Claims 9-11, 15 and 17-19 are currently pending, of which claims 9 and 15 are in independent form.

#### **Rejections Under 35 U.S.C. 103(a)**

Claims 9-11, 15 and 17 stand rejected under 35 U.S.C. 103(a) for obviousness over U.S. Patent Application Publication No. 2003/0134061 to Benim et al. in view of U.S. Patent No. 5,226,585 to Varano. Claim 18 stands rejected under 35 U.S.C. 103(a) for obviousness over Benim in view of Varano, as applied to claim 10, and further in view of U.S. Patent No. 6,303,202 to Washburn et al. Each of these rejections is respectfully traversed.

Benim is directed to an insulated label stock or sleeve that has an insulating layer laminated to a face material. The insulating layer may be composed of a foam, such as a polyurethane or polypropylene foam. (Benim, [0023]) The face material is a film, paper, or fabric material, such as a polyester or thermoplastic film. (Benim, [0026]) In the event the selected face material is not suitable to be printed on, Benim suggests that a coating can be applied to the face material to improve the printing compatibility. (Benim, [0028]) In the Office Action, it is asserted that the insulating layer and face material of Benim qualify as the expanded foam layer and the non-foam layer, respectively, in claims 9 and 15. With respect to claim 17, it is asserted that Benim teaches that the label, or at least the face material, is heat shrinkable. (Benim, Abstract)

With respect to the linear depressions recited in claim 9 and the linear protrusions recited in claim 15, the Office Action appears to assert that paragraph [0036] of Benim teaches a label with irregular, partially thinned portions formed by broadly pressing in a thickness direction. However, this paragraph of Benim is limited to defining the surface of the container around which the insulated label is formed. (“...so that the insulating

packaging material may be formed around containers with regular and irregular contours.” Paragraph [0036] of Benim, *emphasis added*). This paragraph does not appear to discuss depressions or protrusions formed on the label itself. While paragraph [0037] does mention that a surface of the insulating layer (30) can be embossed, the embossing step occurs prior to laminating the insulating layer to the face material, and thus the face material is (presumably) not embossed. Moreover, this paragraph of Benim certainly fails to mention an arrangement where the face material (17) and the insulating layer (30) have linear depressions formed therein, as defined in amended claim 9. Thus, the Office Action is incorrect to the extent it suggests that the insulated label of Benim has either depressions or protrusions formed on an outer side thereof. Moreover, Benim does not address the limitation added to claim 9 herein, namely that both the foam sheet and non-foam layer have linear depressions formed therein.

While it is admitted that Benim fails to discuss linear depressions or linear depressions that have a width of between 0.5 and 3.0 mm, it is asserted that Varano discloses a label wrapped around a cup having linear depressions with a width of approximately 0.76 mm. It is further asserted to be an obvious modification to adjust the label of Benim (which is erroneously referred to in the Office Action as “Sterrett”) to include the linear depressions of Varano in order to provide a convenient gripping surface. However, this rationale to combine Varano and Benim at all is based on the incorrect assumption that Benim teaches a label having an embossed outer surface, which it does not. Thus, the proposed combination of Benim and Varano is not properly supported.

With respect to claim 18, Washburn is cited as suggesting the use of UV curable ink in printing labels. Washburn does not, however, cure the clear deficiencies in the Benim and Varano documents discussed above. Notably, Washburn does not teach a label with a foam sheet having an expanded foam layer, in which an outer side of the label is laminated with a non-foam layer and both the foam sheet and the non-foam layer have linear depressions. Instead, Washburn is directed to a sticker comprising a waterproof base portion including a paper ply, static printed matter, and a resin.

Accordingly, claims 9-11, 15, 17 and 18 are patentable over the cited documents. Thus, the outstanding rejection of these claims under 35 U.S.C. 103(a) should be reconsidered and withdrawn.

New Claim 19 is Patentable Over the Cited Documents

New claim 19 depends from and further limits claim 9 by defining at least a portion of the linear depressions as formed in a lattice pattern. Since claim 19 depends from claim 9, it is believed claim 19 is patentable for at least the reasons discussed above. Moreover, claim 19 is further distinguishable from the cited art of record, and particularly Varano, since the indentations (38) in Varano are only provided in a single direction. In particular, the indentations (38) only extend in a vertical direction with respect to the cup. To the contrary, the linear depressions in the label defined in claim 19 have at least a portion provided in a lattice pattern. One example of such a pattern can be seen in Figure 3(c). While a cup having a wrap like that disclosed in Varano is susceptible to slipping out of one's hand in a vertical direction on account of the direction of the vertically-disposed indentations, a cup having a label like that defined in claim 19, with at least a portion of the depressions formed in a lattice-like arrangement, can better prevent slippage in the vertical direction.

Accordingly, claim 19 is also patentable over the cited documents of record.

Correction of "References Cited" Form PTO-892

Applicant notes that several patents referenced in this or past Office Actions were not properly listed by the Examiner on any Form PTO-892 issued to date. Accordingly, appropriate correction is requested and an updated Form PTO-892 "Notice of References Cited" should be provided. The patents which Applicant believes should be listed on a Form PTO-892 include:

- U.S. Patent No. 6,303,202 to Washburn (discussed in Section 7 of the 03/19/09 Office Action);
- U.S. Patent No. 6,858,283 to Nishizawa et al. (referenced in the Conclusion of the 02/22/08 Office Action);
- U.S. Patent No. 6,387,470 to Chang et al. (referenced in the Conclusion of the 02/22/08 Office Action);
- U.S. Patent No. 4,695,501 to Robinson (referenced in the Conclusion of the 02/22/08 Office Action); and
- U.S. Patent No. 4,055,613 to Kapral (referenced in the Conclusion of the 02/22/08 Office Action).

Applicant thanks the Examiner in advance for addressing this issue.

**CONCLUSION**

For all the foregoing reasons, Applicant submits that the pending claims are patentable over the cited documents of record and are in condition for allowance. Accordingly, reconsideration of the outstanding rejections, submission of a corrected Form PTO-892, and allowance of pending claims 9-11, 15 and 17-19 are respectfully requested.

Respectfully submitted,

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